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SHERIDAN ROSS P.C. 1560 BROADWAY, SUITE 1200 DENVER, CO 80202			EXAMINER WANG, LIANG CHE A	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/622,982  
Filing Date: July 17, 2003  
Appellant(s): CHAN ET AL.

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Jason H. Vicks  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed on 8/15/2007 appealing from the Office action mailed on 2/6/2007.

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**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,480,885	OLIVIER	11-2002
2003/0065727A1	CLARKE et al.	4-2003
6,654,779	TSUEI	11-2003
5,619,648	CANALE	4-1997

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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2. Claims 1, 3, 5-8, 10, 11, 13-17, 19, 21-24, 26, 27, 29-31, 36, 37, 39, 41-44, 46, 47, 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Olivier, US Patent Number 6,480,885, hereinafter Olivier.
3. Referring to claim 1, Olivier teaches a method for processing an electronic message (Col 3 lines 17-22), comprising:
  - a. receiving a message from a sender (Col 5 lines 33-35), the message comprising at least one recipient to receive the message (Col 5 lines 33-40) and including at least one for a restriction identifier (Col 5 lines 17-46, any acceptance criteria parameters could be a restriction identifier) identifying a subset of recipients from among a set of possible recipient (recipients on the mail list before filtering by the acceptance criteria; Col 3 lines 17-22) and access restriction indicating a subset of points of access (Col 5 lines 23-26, Col 12 lines 59-65, other acceptance criteria) from among a set of points of access to access the message (Col 5 lines 17-22);
  - b. determining whether each identified at least one recipient is within the subset of recipients corresponding to the restriction identifier (step 212, Col 5 lines 40-46; and wherein at least one of the following steps is performed:
    - I. when the message comprises the restriction identifier and an identified at least one recipient is not within the subset of recipients, at least one of not providing access to the message to the identified at least one recipient who is not in the subset of recipients (Col 3 lines 17-22; Col 5 lines 47-49, the recipients that are filtered out corresponds to providing access to the message to the identified at

least one recipient who is not in the subset of recipients) and notifying the sender that an identified at least one recipient is not within the subset of recipients; and

- II. when the message comprises the access restriction and identified at least one recipient attempts to access the message from a point of access not within the subset of points of access, not providing access to the message to the identified at least one recipient whose point of access is not within the subset of points of access (Col 3 lines 17-22; Col 5 lines 47-49).

4. Referring to claim 3, Olivier teaches the method of claim 1, wherein the message comprises the restriction identifier and the restriction identifier is located in a body of the message (figure 9, Col 12 lines 59-65).
5. Referring to claim 5, Olivier teaches the method of claim 1, wherein the message comprises the restriction identifier and the restriction identifier is located in an attachment to the message (Col 12 lines 65-67).
6. Referring to claim 6, Olivier teaches the method of claim 1, wherein the message is received by a server associated with at least one recipient from a server associated with the sender (Col 5 lines 6-8, 33-45).
7. Referring to claim 7, Olivier teaches the method of claim 1, wherein the at least one of the restriction identifier and a access identifier is configured as a flag (figure 9).
8. Referring to claim 8, Olivier teaches the method of claim 1, wherein the message comprises the restriction identifier and wherein, when an identified at least one recipient

is not within the subset of recipient, the step of not proving access to the message to the identified at least one recipient who is not in the subset of recipients is performed (Col 3 lines 17-22; Col 5 lines 47-49).

9. Referring to claim 10, Olivier teaches the method of claim 1, wherein the message comprises an age restriction, the age restriction specifying an age limit of the message (Col 14 lines 23-28; figure 9).
10. Referring to claim 11, Olivier teaches the method of claim 1, wherein the message comprises a timestamp indicating when a life of a message starts and further comprising: comparing the expired life of the message with the age restriction to determine whether or not to delete and/or deliver the message to the at least one recipient (Col 14 lines 23-28, Col 18 lines 54-64.)
11. Referring to claim 13, Olivier teaches the method of claim 1, wherein the message comprises the access restriction (Col 5 lines 18-22).
12. Referring to claims 14, 15, claims 14, 15 encompass the same scope of the invention as that of the claim 1. Therefore, claims 14, 15 are rejected for the same reason as the claim 1.
13. Referring to claim 16, Olivier teaches a method for processing an electronic message, comprising: receiving at least part of a message inputted by a user, the at least part of a message comprising at least one recipient to receive the message (Col 5 lines 33-45); receiving, from the user, a restriction identifier for the at least part of a message, the restriction identifier identifying a subset of recipients from among a set of possible

recipients (Col 5 lines 23-45); and when a restriction identifier is received, tagging the message with the restriction identifier (figure 9, Col 12 lines 59-66).

14. Referring to claim 17, Olivier teaches the method of claim 16, wherein, before the message is sent to the at least one recipient, further comprising: determining whether each identified at least one recipient is within the subset of recipients corresponding to the restriction identifier (Col 3 lines 17-22); and when an identified at least one recipients is not within the subset of recipients, at least one of not providing access to the message to the identified at least one recipient who is not in the subset of recipients (Col 3 lines 17-22; Col 5 lines 47-49, the recipients that are filtered out corresponds to providing access to the message to the identified at least one recipient who is not in the subset of recipients) and notifying the sender that an identified at least one recipient is not within the subset of recipients.
15. Referring to claim 19, Olivier teaches the method of claim 16, wherein the message comprises the restriction identifier and the restriction identifier is located in a body of the message (figure 9, Col 12 lines 59-65).
16. Referring to claim 21, Olivier teaches the method of claim 16, wherein the message comprises the restriction identifier and the restriction identifier is located in an attachment to the message (Col 12 lines 65-67).
17. Referring to claim 22, Olivier teaches the method of claim 17, wherein the message is received by a server associated with at least one recipient from a server associated with the sender (Col 5 lines 6-8, 33-45).



18. Referring to claim 23, Olivier teaches the method of claim 17, wherein the restriction identifier is configured as a flag (figure 9).
19. Referring to claim 24, Olivier teaches the method of claim 17, wherein, when an identified at least one recipient is not within the subset of recipient, the step of not proving access to the message to the identified at least one recipient who is not in the subset of recipients is performed (Col 3 lines 17-22; Col 5 lines 47-49).
20. Referring to claim 26, Olivier teaches the method of claim 17, wherein the message comprises an age restriction, the age restriction specifying an age limit of the message (Col 14 lines 23-28).
21. Referring to claim 27, Olivier teaches the method of claim 17, wherein the message comprises a timestamp indicating when a life of a message starts and further comprising: comparing the expired life of the message with the age restriction to determine whether or not to delete and/or deliver the message to the at least one recipient (Col 14 lines 23-28, Col 18 lines 54-64.)
22. Referring to claim 29, Olivier teaches the method of claim 17, wherein the message comprises an access restriction indicating a subset of points of access from among a set of points of access to access the message (Col 5 lines 18-22), and further comprising when an identified at least one recipient is not within the subset of points of access, not proving access to the message to the identified at least one recipient whose point of access is not in the subset of points of access (Col 3 lines 17-22; Col 5 lines 47-49).
23. Referring to claims 30, 31, 36, 37, 39, 41-44, 46, 47, 49, claims 30, 31, 36, 37, 39, 41-44, 46, 47, 49 encompass the same scope of the invention as that of the claims 16, 17, 19, 21-

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24, 26, 27, 29. Therefore, claims 30, 31, 36, 37, 39, 41-44, 46, 47, 49 are rejected for the same reason as the claims 16, 17, 19, 21-24, 26, 27, 29.

***Claim Rejections - 35 USC § 103***

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 2, 4, 18, 20, 38, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olivier in view of Clarke et al., US Publication Number 2003/0065727A1, hereinafter Clarke.

26. Referring to claims 2, 4, 18, 20, 38, 40, Olivier teaches the method and system of claims 1, 16 and 36, wherein the message comprises the restriction identifier and the restriction identifier is embedded within the original email message (Col 12 lines 59-63, figure 9, block 524).

Olivier does not explicitly teach the restriction identifier is located in a header or in a trailer of the message.

However, Clarke teaches other information can be incorporated in any part of email message, such as the subject line or message field (page 4 [0043]).

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have Clarke's method of include information into any part of email to be incorporated with Olivier's restriction identifier such that to have the

restriction identifier to be possibly included in any part of message because both Clarke and Olivier teaches inserting information into an electronic message (Clarke, page 4 [0043]; Olivier Col 12 lines 59-63).

A person with ordinary skill in the art would have been motivated to make the modification to Olivier because having the restriction identifier to be possibly included in any part of email would facilitate proper handling of the customer's message in different system as taught by Clarke (Page 4 [0043] lines 3-6)).

27. Claims 9, 25, 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olivier in views of Tsuei, US Patent Number 6,654,779, hereinafter Tsuei.

28. Referring to claim 9, 25, and 45, Olivier teaches the method and system of claims 1, 17 and 36, when an identified at least one recipient is not within the subset of recipients, not providing access to the message identified at least one recipient (Col 3 lines 17-22; Col 5 lines 47-49, the recipients that are filtered out corresponds to providing access to the message to the identified at least one recipient who is not in the subset of recipients).

Olivier does not explicitly teaches the notifying the sender that an identified at least one recipient is not within the subset of recipients.

However, Tsuei teaches notifying the sender if the message could not be delivered to the recipient (Col 10 lines 7-11).

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate Tsuei's method of notifying recipients if the message could not be delivered with Olivier such that the sender would be notified when the message in Olivier's system is undeliverable to the filtered recipients, because both

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Tsuei and Olivier teaches methods of handling email messages (Tsuei, Col 10 lines 7-11; Olivier Col 3 lines 18-22).

A person with ordinary skill in the art would have been motivated to make the modification to Olivier because having the sender notified when the recipient are not receiving the message would allow sender to be aware of the fact that the communication is not established to the recipient as taught by Tsuei (Col 10 lines 7-11).

29. Claims 12, 28, 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olivier in views of Canale et al, US Patent Number 5,619,648, hereinafter Canale.

30. Referring to claims 12, 28 and 48, Olivier teaches the method and system of claims 1, 17 and 36, wherein the message comprises the restriction identifier (Col 5 lines 15-46).

Olivier does not teach a restriction indicating at least one of (a) whether the message may be forwarded and (b) to whom the message may be forward.

However, Canale teaches a forwarding restriction indicating to whom the message may be forwarded (Col 3 line 54 – Col 4 line 8).

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate a forwarding restriction of Canale in Olivier such that the sender would have the option to automatically forward a message, because both Canale and Olivier teaches methods of handling email messages (Canale Col 3 lines 36-55; Olivier Col 3 lines 18-22).

A person with ordinary skill in the art would have been motivated to make the modification to Olivier because having the forwarding restriction would allow sender to

allow message forwards to be complete automatically as taught by Canale (Col 4 lines 4-9).

**(10) Response to Argument**

1. Appellant argues, Olivier and Canale do not teach the limitation of “wherein the message comprises a forwarding restriction indicating at least one of (a) whether the message may be forwarded and (b) to whom the message may be forwarded.”

In response to appellant’s argument, it’s the combination of Olivier and Canale, that teaches the claimed limitation, not Canale alone. Olivier teaches the restriction identifier in the message as claimed in claim 1, Olivier is lacking a forwarding restriction. Canale suggests restriction on forwarding for e-mail messages (in Col 3 lines 64-67 teaches a mail filter that filters emails by forwarding mail items to the correspondents, the action of filtering with forwarding based on the referral list corresponds to a “forwarding restriction”). The Examiner combines the suggested forwarding restriction of Canale with the mail restriction in Olivier to allow automatic forwarding based on user’s pre-selected preferences (Col 4 lines 4-9).

2. Appellant argues, it is abundantly clear that in Olivier, it is the end user (i.e the recipient) that is specifying the acceptance criteria data – not the sender as set forth in Independent claim 1.

In response to appellant’s argument, Olivier in figure 9 and Col 12 lines 57-65, shows that an email message from an unknown user (sender) having the

profile and criteria (restriction identifier). It is clear that the sender can specify the criteria data as claimed in independent claim 1.

3. Appellant argues, nowhere in Olivier is there a teaching of identifying a recipient that may or may not be a part of a subset of recipients from among a set of possible recipients.

In response to appellant's argument, Olivier teaches the invention for filtering emails (Col 3 lines 17-22), the recipients on the mail list prior to filtering by the acceptance criteria corresponds to "a set of possible recipient", and the recipients after filtering corresponds to "a subset of recipients". The filtering process corresponds to "identifying a recipient that may or many not be a part of a subset of recipients from among a set of possible recipients".

4. Appellant argues, Olivier makes clear that a "recipient" refers to a person or subscriber and not a device. Olivier does not distinguish between which of the matching subscriber's receives the email let alone specify that the matching subscriber cannot access the message at some of that subscriber's message retrieval nodes.

In response to appellant's argument, first, the claimed "recipient" does not preclude a device. Second, a person must use a device to receive electronic messages.

5. Appellant argues, Olivier fails to teach, suggest, or describe tagging a message with a restriction identifier that will negatively restrict access to that message.

In response to appellant's argument, Figure 9, and Col 12 lines 57-65 of Oliver shows "tagging a message with a restriction identifier" (#criteria# 524). The limitation "negatively restrict access" argued by the appellant is not claimed.

6. Appellant argues, Olivier fails to teach, suggest, or describe a message that comprises a restriction identifier, and when an identified recipient is not within a subset of recipients, not providing the identified recipient access to the message even though the identified recipient was listed as a recipient in the message as in recited in claims 8, 17, 24, 37, and 44.

In response to appellant's argument, Olivier teaches the invention for filtering emails (Col 3 lines 17-22), therefore the recipients on the mail list prior to filtering by the acceptance criteria corresponds to "a set of possible recipient", and the recipients after filtering corresponds to "a subset of recipients". The purpose of filtering is to filter out and not allow the filtered recipient to read (access) the message.

7. Appellant argues, Oliver does not teaches where in the message comprise an age restriction, the age restriction specifying an age limit of the message as recited in claim 10, 26, and 46.

In response to appellant's argument, Figure 9 shows an age limit as broadly claimed. Only the recipients in the age between 20 and 50 could receive this message.

8. Appellant argues, Oliver does not teach, suggest, or describes every claim element in claims 11, 27 and 47.

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In response to appellant's argument, the Examiner agrees with the appellant, claims 11, 27 and 47 should be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Liangche Alex Wang 

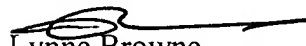
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